

Application No. 09/808,524
Amendment dated November 5, 2003
Reply to Office Action dated June 05, 2003

REMARKS

The non-final Office Action mailed June 5, 2003 has been reviewed in detail. The Examiner will note that selected claims have been amended in response. In addition, arguments in support of patentability are provided below. Reexamination and reconsideration of the application as amended are respectfully requested.

The indication of allowable subject matter in claim 1-4 and 7-10 is appreciated, and applicant has attended to the claim objections as noted on page 2 of the Office Action. The Examiner's assistance in that regard is greatly appreciated.

With regard to the claim rejections, namely to claims 11, 12, 13, 15-20, and 22 on the basis of various combinations of Caldwell – U.S. Patent No. 4,403,895 (“Caldwell”) as modified by Hamamoto – U.S. Patent No. 5,695,666 (“Hamamoto”) and/or Stokes – U.S. Patent No. 3,517,581 (“Stokes”), or Schmidt – U.S. Patent No. 5,252,016 (“Schmidt”), applicant respectfully requests reconsideration. Claim 14 was not rejected on the basis of prior art. Accordingly, its limitation has been incorporated into claim 11. In light of the absence of a prior art rejection, this claim (and claims dependent therefrom) is deemed patentable over the prior art.

With regard to method claim 16, the Examiner cites the Stokes patent for teaching “that it is well known to self-pierce a substrate by initially drilling at a first rotational velocity while then advancing the threads at a second, slower rotational velocity.” From this, the Examiner concludes that Stokes is properly combinable with Caldwell to meet the claim limitations. This interpretation and ultimate conclusion of unpatentability are respectfully traversed. First, Stokes is directed to drilling and tapping issues associated with metal workpieces, whereas the present application is directed to non-metal application, particularly a weatherseal which is usually an elastomeric material. Moreover, the teaching in Stokes that the Examiner is relying on must relate to the prior art description in column 1 of that patent. When Stokes is viewed in its entirety, it becomes apparent that in fact Stokes teaches away from such an arrangement and indicates that such prior art arrangements (i.e., two different rotational velocities) have their own disadvantages. The invention of Stokes is not directed to two different rotational velocities as suggested by the Examiner. Accordingly, Stokes, if combined with Caldwell, would actually teach away from the express limitations of claim 16 requiring rotating


Application N . 09/808,524
Amendment dated November 5, 2003
Reply to Office Action dated June 05, 2003

the peg at a first rotational velocity and subsequently rotating the fastening pin at a slower, second rotational velocity. Since one skilled in the art would not be prompted to use the teachings of Stokes with Caldwell, it is not fair to conclude that the teachings can be properly combined. Accordingly, claim 16 and claims 18-20 and 22 dependent therefrom are already deemed patentable over the art of record. As such, claims 1-4, 7-20, and 22 are deemed to define over the prior art.

Since all formal and informal matters have been addressed this application is in condition for allowance. Early notice to that effect is earnestly solicited.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP


Timothy E. Mauman
Reg. No. 32,283
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2518
216/861-5582